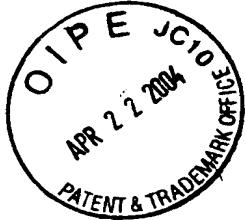


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3621

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES



In re Application of:

Bruce Ha, et al.

HYBRID OPTICAL RECORDING
DISC WITH COPY PROTECTION

Serial No. US 09/393,527

Filed 10 September 1999

Group Art Unit: 3621

Examiner: James A. Reagan

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Perry J. Clements

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Introduction

This Reply responds to selected issues raised in the Answer. The majority of the Answer (Pages 3-14) is a copy of the rejections found in the Final Rejection. Appellant's comments on those rejections were made of record in Appellant's main Brief.

A Fundamental Error of Reference Interpretation

The Examiner misinterprets and misapplies the Yamagishi reference. It has one ID in two places. It does not have a DID and a unique SID. Nor does it have three IDs.

Claim 9 requires two identifiers at specified locations. A DID, common to other discs, is in the ROM and an SID, unique to each disc, is in the RAM. Claim 9 is clearly contrary to Yamagishi. In Claim 9, the SID is unique and thus cannot be the same as the DID. If the subject matter of claim 9 was put into a Yamagishi disc, the anti-piracy protection scheme of Yamagishi would stop the disc from operating.

The other claims all have three IDs. No reference shows three IDs on a disc or suggests the claimed three IDs in their claimed locations. Yamagishi is the only

reference for a hybrid (RAM and ROM) optical disc that is applied to the claims. The Spitzenerger and Oshima reference are ROM only disc.

Appellants attack the Yamagishi reference piecemeal because it does not have the fundamental three pieces of the invention: a DID, a PID and an SID. Yamagishi has one ID that is stored in two places. It is permanently stored on the disc and a “coincident”¹ ID is stored in the RAM. See Yamagishi, column 2, lines 40-48. The term “coincident” means in the same place, congruent or identical. Yamagishi thus requires that the two IDs be the same (coincident) for its disc to operate. If the IDs are different it stops. As such, Yamagishi does not have the particular two-ID disk of Claim 9 and does not have the three-ID structure for the other claims.

The Board Should Make a Finding on the Number, Type and Location of Identifiers in the Yamagishi Reference.

A key issue in this appeal is the number, type and location of identifiers in the Yamagishi reference. Appellant contends that Yamagishi shows one identifier at two places and does not show the three identifiers, DID, PID and SID of the claims.

The Examiner disagrees and finds that Yamagishi has three identifiers. That finding is erroneous because the Examiner twice uses the same identifier in Yamagishi for different elements of the claims. The Examiner finds that Yamagishi column 2, lines 49-63 includes the PID and the SID of the claims. That is erroneous because it is a finding, in effect, that 1=2. Yamagishi column 2, lines 49-63 discloses that its DID is also stored in the RAM area. Let us assume for the sake of argument, that the “coincident” ID is really a second ID. Even so, it is not a unique ID and so Claim 9 is patentable over Yamagishi. But Yamagishi still lacks the third ID of the other claims. As such, that portion of Yamagishi relied upon for rejection does not provide any basis for a finding that the Yamagishi shows the three IDs (DID, PID and SID) of the other claims.

¹ An on-line dictionary, Dictionary.com, gives the following definitions for “coincident”:

1. Occupying the same area in space or happening at the same time: *a series of coincident events*
2. Being very similar to another, as in nature: *testimony that was coincident with the actual facts*.
3. Matching point for point; coinciding: *coincident circles*.

Only the last two meanings are relevant to Yamagishi. Very similar or coincident IDs are identical IDs.

The Examiner Failed to Make a Prima Facie Case for an Obviousness Rejection

MPEP Section 2142 explains the standard for making a prima facie case for obviousness. There are two components. First, an examiner must find all the limitations in the prior art. Second, an examiner must demonstrate that the prior art shows or suggests motivation to combine the limitations in the manner of the claims. The claims themselves and the application cannot be used to provide a blueprint for assembling the limitations from the prior art.

The rejections of record fail to meet both criteria. The Answer criticizes the Appeal Brief on grounds it attacks the references piecemeal and does not address the overall combination proposed by the rejection. That criticism is misplaced. It is proper to attack references piecemeal when the references do not supply the pieces that comprise the invention. If the references do not have the limitations of the claims, then the references do not and cannot support the rejection.

Yamagishi does not have three disc IDs. It has one ID in two places. The Examiner found that Yamagishi has **three** IDs and then substituted IDs of other references for the PID and the SID of the claims. Appellants disagree and attack Yamagishi because it does not show a disc with three IDs.

The references do not suggest the combination of the claims. Yamagishi is the only reference applied against the claims that has ROM and RAM on an optical disc. The premise of the rejection is that Yamagishi provides the basic two or three ID structure found in the claims. That is incorrect. Yamagishi has only one ID, albeit the same ID is used in two places. Yamagishi does not have a common DID and unique SIDs for each disc.

Spitzenberger and Oshima have no RAM. At most, one skilled in the art might substitute an ID from their ROM's for the ROM ID of Yamagishi. The result would be Yamagishi's hybrid optical disc with the ID of Spitzenberger or Oshima in two places on the disc. That is far short of the claimed three-ID disc.

The Answer Misconstrues "and" for "or"

The Answer misunderstands and misquotes Appellant's first Argument. Page 8 of Appellant's Brief states that Yamagishi did not show DID, PID **and** SID identifiers. But the Answer says Appellant argued "Yamagishi does not show a DID, PID **or** SID. . . .(Emphasis added)" That is incorrect. The Answer substitutes "or" for

Appellant's "and." Appellant argued that the reference did not show **three** IDs, but only **two**.

Professional Opinion of Examiner Is Not a Legitimate Ground for Rejection

Applicants argued that Yamagishi did not place its SID in the recordable area of the disc as required by claims 2, 5, 9, 10, 11 and 13. The Examiner concedes this is correct or at least made no finding to the contrary. Instead, the basis for refusing allowance is a statement found in the last sentence of the first paragraph on page 15, "It is the **professional opinion of the Examiner** that it would be an obvious modification to one of ordinary skill in the optical medium recording arts **to allow an ID to be recorded in either the recordable area or the non-recordable area without placing undue burden on the public.**" (Emphasis added.)

The Examiner cites no authority in statute, rule, MPEP or case law that supports an obviousness rejection for locating an element of a claim based on the professional opinion of the examiner. The Examiner is, in effect, characterizing himself as one of ordinary skill and then making a finding based on his self-characterization. That is not professional opinion; it is hindsight.

The basis for the opinion is unclear. Is the Examiner opining as **one of ordinary skill?** Appellants admit the Examiner has skill in the art, but neither the law nor the record sanctions the Examiner as one of **ordinary skill.** Instead, examination is supposed to be based upon objective criteria, in particular what is shown or suggested in a reference. See MPEP Section 2142.

The rejection is further erroneous because it is based upon what the prior art "allows." Again, no statute, rule, or case is provided to support such a rejection. A finding based on what the prior art "allows" is subjective. Appellants traverse this finding and challenge the Examiner to provide a case showing that "allowance" by the prior art is an indication of obviousness.

Appellants also challenge the finding about "undue burden upon the public." The meaning of that finding is unclear. Does the Examiner mean the public will be unduly burdened by the issue of this application as a patent? All patents are a burden on the public and the public's burden is not the concern of the Examiner. The Constitution and Congress have sanctioned patents and they cannot be second guessed by subjective opinions of examiners. No examiner has authority to judge whether a patent duly or unduly burdens the public. Instead, an examiner's responsibility is to

examine applications and to allow them when the applications satisfy objective criteria for novelty, usefulness and non-obviousness.

But perhaps the finding about undue burden means the Examiner found it would be easy to implement the invention and thus not an undue burden for the public to copy the invention? If so, the Appellant agrees. Indeed, copying of software related inventions is remarkably easy. However, the ease of infringement has never been a criterion for granting a patent.

Oshima Does Not have Three IDs on its Disc

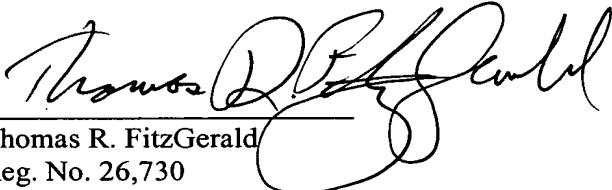
The Answer on page 16 finds there are “three” IDs of Oshima. That finding is erroneous. The Examiner uses the **drive ID** of Oshima as one of the disc IDs of the claims. That is clearly erroneous. The claims call for IDs to be on the disc, not on the drive. The Answer provides no support for its selection of the drive ID of Oshima and its addition of the drive ID to a disc.

In summary, the Answer contains numerous errors in fact and law. The references do not show the claimed elements in the claimed combination and the professional opinion of the Examiner about a factual issue is not a legal basis for making a rejection.

Respectfully submitted,

4/19/04

Date



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